UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MOHAMMAD A. ABDALLAH and VLADIMIR PENTKOVSKI

Appeal No. 2006-1169
Application No. 10/005,728

ON BRIEF

Before THOMAS, KRASS, and BLANKENSHIP, *Administrative Patent Judges*.

KRASS, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants request rehearing with regard to our decision of June 13, 2006, sustaining the rejection of claims 17, 26-31, and 33-37 under 35 U.S.C. § 112, second paragraph, as being indefinite.

We found the claims to be indefinite because of the inclusion of the trademark PENTIUM therein. We found that it was not the use of the trademark, per se, that makes the claims indefinite, but, rather, that the use of that particular trademark in these claims failed to particularly point out and distinctly claim the subject matter considered by appellants to be the invention. We concluded that the claims were indefinite because the artisan could never be sure what product is being referenced by the use of the term PENTIUM since this mark describes various products which change from time to time.

Appellants contend that we have not read this limitation as the skilled artisan would be deemed to have read the term not only in the context of the particular claim in which the term appears, but in the context of the entire patent, including the specification.

We agree with appellants in their statement of the law as expressed in Phillips v. AWH Corp, 415 F.3d 1303, 1313; 75 USPQ2d 1321, 1326 (Fed. Cir. 2005). However, we do not agree with their application of the law in the present context. The instant specification sets forth no special meaning to, and no special version of, the PENTIUM product. If the claims were limited to a specific version of the PENTIUM product that could be identified

with specificity, then we would agree that the claimed subject matter would be definite and pass muster under 35 U.S.C. § 112, second paragraph. But, as described, and claimed, the PENTIUM product referred to may be any one of many products, e.g., PENTIUM II chip, PENTIUM III chip, etc. Each version of the product is at least slightly different than another version of the product, with different instruction sets. If a patent on a claim containing merely the term "PENTIUM" were to issue, the question arises as to how would one know what infringes that particular patent. Would the use of *any* PENTIUM product infringe? It might, and there is nothing intrinsically wrong with claiming an invention broadly. Breadth should not be confused with indefiniteness. But since Intel generates different versions of PENTIUM products, if the claims covered all the PENTIUM chips and their instruction sets in use and known up until the time of the instant invention, that would be one thing. But, when Intel attaches the PENTIUM name to future products, as they very well may since it is a very valuable trademark, how will the artisan know what the claimed term PENTIUM is to cover? Is a claim meant to cover all future developments which may not even be contemplated at the time of the patent application?

If the present claims should protect all of the instruction sets of all the known PENTIUM chips in existence at the time of the invention, what is to happen to an independent inventor who invents a new program, or sequence of instructions, different and unobvious over the currently existing PENTIUM chips? If Intel were to include such steps in a future version of the PENTIUM chip, would the instant claims preclude that independent inventor from his own invention because Intel has a patent claim that seemingly excludes others from making, using, and selling any instruction set which resides, or which may, in the future, reside, in a chip with the PENTIUM label?

Thus, in our view, the use of the term PENTIUM fails to make clear to the artisan what, exactly, is entailed by that term and what, exactly, would be deemed to infringe a patent with such claims.

At page 8 of the request for rehearing, appellants point to page 9, line 14, through page 10, line 10 of the instant specification, wherein it states, in part, that "In one embodiment of the invention, the processor 105 supports the Pentium® microprocessor instruction set and the packed data instruction set 145." At page 9 of the request for rehearing, appellants contend that "...a competitor capable of making a

processor to execute the PENTIUM microprocessor instruction set as well as another packed data instruction set, would understand the inventor's intent to take a processor having a standard microprocessor instruction set, such as the PENTIUM microprocessor instruction set, including a packed data instruction set and to use disclosed aspects of the invention to produce a PSAD instruction."

This argument by appellants highlights our concern. When appellants talk about a competitor capable of making a processor "to execute the PENTIUM microprocessor instruction set," exactly what instruction set would that be? An instruction set in the latest version of the PENTIUM chip? Some as-of-yet unknown instruction set in some future version of the PENTIUM chip? It is indefinite. The artisan would not be informed as to just what instruction set is being described in the claims comprising the term "PENTIUM." Even the description of the PENTIUM processor types at pages 9-10 of the request for rehearing admits that there are some differences in the instruction sets of various PENTIUM products.

Although appellants assert that the phrase, "instructions of the PENTIUM microprocessor instruction set" had a "fixed and definite meaning as a well established *de facto* standard of compatibility..." (page 12 of the request for rehearing), appellants have not set forth what, exactly, that "fixed and definite meaning" is.

Since we cannot determine the metes and bounds of the instant claimed subject matter because the term "PENTIUM" is not specific as to any one processor or any one instruction set, and the processor and/or instruction set which it describes is subject to change, we continue to believe that claims 17, 26-31, and 33-37 are indefinite within the meaning of 35 U.S.C. § 112, second paragraph.

Since we are unconvinced of any error in our decision regarding our affirmance of the rejection of claims 17, 26-31, and 33-37 under 35 U.S.C. § 112, second paragraph, we remain convinced of the correctness of our decision in summarily reversing the rejection of these claims based on 35 U.S.C. § 103 in accordance with In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

We have granted appellants request to the extent that we have reconsidered our decision of June 13, 2006, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

JAMES D. THOMAS
Administrative Patent Judge)

ERROL A. KRASS
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES

HOWARD B. BLANKENSHIP
Administrative Patent Judge)

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